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09/974,776	10/11/2001	Walter Rosenbaum	2001P17847US	6886

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT

PAPER NUMBER

3621

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/974,776	<b>Applicant(s)</b> ROSENBAUM ET AL.	
	<b>Examiner</b> Mary Cheung	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the application filed on October 11, 2001. Claims 1-29 are pending.

### ***Claim Objections***

2. Claims 1, 3 and 17-18 are objected to because of the following informalities:
  - a) In line 12 of claim 1, the word "an" should be "a";
  - b) In line 2 claim 3, the phrase "code." should be code, and the phrase "address;" should be "address.";
  - c) In line 1 of claim 17, the phrase "claim 1" should be "claim 16" in order to avoid a 112 2<sup>nd</sup> paragraph rejection;
  - d) In line 1 of claim 18, the phrase "claim 1" should be "claim 16" in order to avoid a 112 2<sup>nd</sup> paragraph rejection.Appropriate correction is required.

### ***Specification***

3. The disclosure is objected to because of the following informalities:
  - a) the word "SMS" disclosed in page 3 line 12 and page 8 line 1 is not defined;
  - b) the contents that associated with Fig. 1B (i.e. page 6 line 18 - page 7 line 19) should be deleted because the most recent submitted drawings on January 17, 2003 does not include Figure 1B;

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c) in page 9 line 9, the number "38" should be "36". Appropriate correction is required. For examination purpose, the word "SMS" will be interpreted as "Short Message Service".

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 7, it is not clear what the word "SMS" mean. For examination purpose, the word "SMS" will be interpreted as "Short Message Service".

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-3, 7, 9-10, 13, 15-18, 20-21 and 23-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-3, 7, 9-10, 13, 15-18, 20-21 and 23-29 only recite an abstract idea. The recited steps of merely providing mail piece franking to a customer does not apply, involve, use, or advance the technological arts since all of the recited steps **can be performed in the mind of the user or by use of a pencil and paper**. These steps only constitute an idea of how to providing mail piece franking over another.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces tracking code on a mail piece (i.e., useful, concrete, and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1-3, 7, 9-10, 13, 15-18, 20-21 and 23-29 are deemed to be directed to non-statutory subject matter. Applicant is advised to implement computer technology into the independent claim 1 in order to overcome the rejection, such as "electronically generating an alphanumeric frank code...", "electronically verifying authenticity of...", etc.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-11, 13-15, 21-24 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeung, U. S. Patent 6,101,487 in view of Allum et al., U. S. Patent 5,420,403.

As to claim 1, Yeung teaches a method of providing mail piece franking by a party to a customer, comprising the steps of (abstract and Fig. 1):

- a) receiving a request from a customer for franking from said party, said request including mail piece information, said information comprising payment means (column 2 line 60 – column 3 line 37 and column 3 lines 61-67 and column 4 lines 15-20 and Fig. 1);
- b) generating an alphanumeric franking code based on an algorithm, said code related to said information (column 3 lines 2-18 and Figs. 1-2);
- c) transmitting said franking code to said customer (column 3 lines 37-43 and Fig. 1);
- d) affixing, by said customer, said franking code to said mail piece or mail piece (column 3 lines 40-43 and column 4 lines 34-40);
- e) receiving by said party said mail piece or mail piece with franking code affixed thereon (column 4 lines 34-40 and Fig. 1);

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f) verifying authenticity of said franking code (column 4 line 34 – column 5 line 3 and Fig. 1).

Yeung further teaches supporting various types of application for processing mail pieces, such as cost tracking (column 5 lines 12-17). Yeung does not specifically teach printing a tracking code on said mail piece or mail piece if said franking code is authentic. However, Allum teaches printing a tracking code (Fig. 4). It would have been obvious to one ordinary skill in the art at the time the invention was made to allow Yeung's teaching to include the feature of printing a tracking code on the mail piece if the frank code is authentic so that the authenticated mail pieces can be distinguished from the unauthenticated mail pieces.

As to claim 2, Yeung teaches wherein said information further comprises date of purchase of said franking code (Fig. 2).

As to claim 3, Yeung teaches wherein said information further comprises date of purchase of said franking code or delivery address (Fig. 2)

As to claim 4, Yeung teaches wherein said request is made over the Internet (column 4 lines 18-19 and Fig. 1).

As to claim 5, Yeung teaches wherein said request is made by a dial up computer connection (column 4 lines 18-19 and Fig. 1).

As to claim 6, Yeung teaches the request is made by online computer (column 4 lines 18-19 and Fig. 1). Yeung does not specifically teach said request is made by telephone. However, using telephone to make request is well known in the art. It would have been obvious to one of ordinary skill in the art to allow the request in Yeung's

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teaching to be made via telephone for allowing the customer quickly and easily making the request.

As to claim 7, Yeung said request is made by electronic messages (column 5 lines 12-17). Yeung does not specifically teach that the electronic messages are short message service. It would have been obvious to one of ordinary skill in the art to allow the electronic messages in Yeung's teaching to be short message service so that the communication between the customer and the party can be quickly and easily accomplished.

As to claim 8, Yeung teaches said request is made by e-mail (column 5 lines 12-17).

As to claim 9, Yeung teaches said franking code comprises a transaction number and said step of generating further comprises the step of linking and storing said transaction number and delivery address in a first database (column 4 lines 50-53 and Figs. 1-2).

As to claim 10, Yeung teaches reading said affixed franking code and delivery address and determining if a match to said read franking code and delivery address is present in said first database (column 4 line 34 – column 5 line 3).

As to claim 11, Yeung does not specifically teach the step of reading is performed by a scanner comprising optical character recognition means. However, Allum teaches this matter (column 4 lines 15-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow one of ordinary skill in the art at the time the invention was made to allow the reading step in Yeung's

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teaching to be performed by a scanner that comprises OCR means as taught by Allum so that the mail pieces can be processed easily and quickly.

As to claim 13, Yeung teaches marking said mail piece or mail piece with characters indicating presence of said franking code (Fig. 1).

As to claim 14, Yeung modified by Allum further teaches said tracking code is a bar code (Yeung: Fig. 1; Allum: abstract).

As to claim 15, Yeung teaches said franking code comprises a character symbol and four numerals (Figs. 1-2).

As to claim 21, Yeung modified by Allum further teaches printing is performed manually (Yeung: Fig. 1; Allum: Fig. 5).

As to claim 22, Yeung modified by Allum teaches printing is performed by a printer (Yeung: Fig. 1; Allum: Fig. 5).

As to claim 23, Yeung modified by Allum teaches printing is performed by labeling means (Yeung: Fig. 1; Allum: Fig. 5).

As to claim 24, Yeung teaches relaying to a third party read affixed franking code; third party authenticating of said franking code; and communicating results of said step of authenticating to said party (column 4 line 34 – column 4 line 6 and Fig. 1; *specifically, "third party" corresponds to the data reconciliation application in Yeung's teaching*).

As to claim 26, Yeung teaches said party is a post office (abstract and Fig. 1).

As to claim 27, Yeung teaches said party is a national post office (abstract and column 1 lines 36-37).

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As to claim 28, Yeung teaches said party is a corporation (abstract and column 1 lines 36-37).

As to claim 29, Yeung generating a personal identification number (PIN); providing the PIN to the customer by the party; storing said PIN; requesting said PIN from said customer after said mail piece has been posted; comparing said requested PIN to said stored PIN, wherein a match indicates authenticity of said franking code (column 2 lines 47-49 and column 4 line 45 – column 5 line 3 and Fig. 1-2).

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yeung, U. S. Patent 6,101,487 in view of Allum et al., U. S. Patent 5,420,403, in further view of Tamada, U. S. Patent 4,641,753.

As to claim 12, Yeung modified by Allum teaches using a scanner to read mail pieces as discussed above. Yeung modified by Allum does not specifically teach said scanner is a videocoding device. However, Tamada teaches this matter (abstract and Fig. 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the scanner in the teaching of Yeung modified by Allum to be a videocoding device for better examination of the mail pieces.

11. Claims 16-19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeung, U. S. Patent 6,101,487 in view of Allum et al., U. S. Patent 5,420,403, in further view of Jones, U. S. Patent 5,181,245.

As to claims 16-17, Yeung modified by Allum teaches encryption algorithm (Yeung: column 2 lines 49-52). Yeung modified by Allum does not specifically teach the franking code comprises a precode, daily code and resulting code, said resulting code

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formed by application of said daily code and precode to said algorithm, and said algorithm is an encryption algorithm. However, this concept is taught by Jones as applying an encryption algorithm on plurality of data, such as stored value, seed number, day's data to produce a result value (column 3 line 64 – column 4 line 30 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the algorithm in the teaching of Yeung modified by Allum to encrypt plurality of data and produce a result value as taught by Jones for enhancing security (Jones: column 3 lines 66-67).

As to claim 18, Yeung modified by Allum does not specifically teach reading said resulting code, generating a second resulting code by applying said algorithm to said precode and daily code, and comparing said resulting code and second resulting code, such that matching first and second resulting codes indicates authenticity. However, this concept is taught by Jones as generating a second resulting value by applying the same algorithm to the same said of plurality of data, such as stored value, seed number, day's data, and comparing said result value and the second result value, allowing operation of the postage meter if said result value and the second result value match (column 3 line 64 – column 5 line 35 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow verifying procedure in the teaching of Yeung modified by Allum to include the feature of generating a second resulting value by applying the same algorithm to the same said of plurality of data, such as stored value, seed number, day's data, and comparing said result value and the second result value, allowing operation of the postage meter if said

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result value and the second result value match for enhancing security (Jones: column 3 lines 66-67).

As to claim 19, Yeung modified by Allum teaches reading is performed by a scanner comprising optical character recognition means (see claim 11 above).

As to claim 25, Yeung teaches delivering said mail piece by said party if said code is authentic; and halting delivery of said mail piece by said party if said code is not authentic (column 4 line 34 – column 5 line 3 and Fig. 1).

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yeung, U. S. Patent 6,101,487 in view of Allum et al., U. S. Patent 5,420,403, in further view of Gu, U. S. Patent Application Publication 2002/0092030 A1.

As to claim 20, Yeung modified by Allum does not specifically teach deleting said franking code from a list of available franking codes, unless a flag is present indicating multiple use of said franking code. However, Gu teaches using flag to indicate data type (paragraph 38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the frank codes in the teaching of Yeung modified by Allum to include the feature of using flag to indicate the data type as taught by Gu for better organizing the frank codes. Furthermore, it would have been obvious to one of ordinary skill in the art to allow the teaching of Yeung modified by Allum and Gu to include the feature of using the flag to indicate if the frank code is useful and delete the frank code if it is not useful for optimizing the storage capacity.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kim et al. (U. S. Patent 5,878,136) discloses encryption key control system for mail processing system having data center verification.

Berson (U. S. Patent 5,929,415) discloses postage metering refill system that utilizes information contained in information based indicia to audit the franking processing.

McFiggans et al. (U. S. Patent 6,032,138) discloses metering incoming mail.

Giham (EP 0 732 673 A2) discloses verification of postage charges.

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***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306      (Official Communications; including After Final  
Communications labeled "BOX AF")

(703) 746-5619      (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
December 27, 2004

